

**REMARKS**

Entry of the foregoing amendments is respectfully requested.

**Summary of Amendments**

Upon entry of the foregoing amendments, claims 1-17 are cancelled and claims 18-37 are added, whereby claims 18-37 will be pending, with claims 18, 36 and 37 being independent claims.

Support for the new claims can be found throughout the present specification (see, e.g., page 41 and the Examples) and in the cancelled claims.

Applicants emphasize that the cancellation of claims 1-17 is without prejudice or disclaimer, and Applicants expressly reserve the right to prosecute the cancelled claims in one or more continuation and/or divisional applications.

**Summary of Office Action**

As an initial matter, Applicants note with appreciation that the Examiner has indicated consideration of the Information Disclosure Statement filed August 18, 2004 by returning a signed and initialed copy of the Form PTO-1449 submitted therein.

Applicants also note with appreciation that the Examiner has acknowledged the claim for foreign priority under 35 U.S.C. § 119(a)-(d) and (f) and the receipt of certified copies of the priority documents.

The restriction and election of species requirements are made final and claims 9, 10, 16 and 17 are withdrawn from consideration.

Applicants note with appreciation that claim 15 is indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (in this regard, see claim 36 submitted herewith).

Claims 1-7, 11 and 12 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schreiber et al., U.S. Patent No. 6,613,338 (hereafter “SCHREIBER”) in view of Fujiyama et al., U.S. Patent No. 3,957,969 (hereafter “FUJIYAMA”).

Claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over SCHREIBER in view of FUJIYAMA and in further view of Butuc, U.S. 2002/0055562 A1 (hereafter “BUTUC”).

Claims 13 and 14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over SCHREIBER in view of FUJIYAMA and in further view of Fabrisi, U.S. Patent No. 5,860,756 (hereafter “FABRISI”).

### **Response to Office Action**

Reconsideration and withdrawal of the rejections of record are respectfully requested, in view of the foregoing amendments and the following remarks.

#### ***Response to Rejection of Claims 1-7, 11 and 12 under 35 U.S.C. § 103(a) over SCHREIBER in View of FUJIYAMA***

Claims 1-7, 11 and 12 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over SCHREIBER in view of FUJIYAMA. The rejection essentially alleges that SCHREIBER teaches a water-in-oil emulsion which shows all of the features which are recited in the rejected

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claims with the exception that SCHREIBER does not teach a composition with 5-50% by weight of glycerol that is spreadable and storage-stable in a temperature range from -10°C to 50°C. In this regard, the rejection relies on FUJIYAMA and asserts that this document discloses the missing features wherefore it would allegedly have been obvious to one of ordinary skill in the art to provide the subject matter of the rejected claims.

Applicants respectfully traverse this rejection. Specifically, it is noted that according to the present independent claims the water-in-oil emulsion recited therein comprises from 5% to 50% by weight, based on the total weight of the emulsion, of at least one skin-moisturizing agent selected from glycerol, chitosan, Fucogel, propylene glycol, polyethylene glycol, dipropylene glycol, butylene glycol, mannitol, lactic acid, polyethylene glycol, glycine, sodium pyrrolidonecarboxylic acid, hyaluronic acid, urea, and salts thereof.

In comparison, SCHREIBER does not specifically mention any of the skin-moisturizing agents recited in the present independent claims, let alone any amounts thereof. Only most (but not all) of the emulsions of the Examples of SCHREIBER contain glycerol. However, in the emulsions of SCHREIBER which contain glycerol, glycerol is invariably present in a concentration of 2 % by weight, i.e., only 40 % of the lower value of the range recited in the present independent claims.

Accordingly, the question arises what would have motivated one of ordinary skill in the art to employ in an emulsion according to SCHREIBER glycerol in a concentration which is at least 2.5 times the concentration that is employed (if at all) in the Examples of SCHREIBER.

The Examiner apparently takes the position that one of ordinary skill in the art would have been motivated by FUJIYAMA to use glycerol in the emulsions of SCHREIBER in a concentration

of at least 5 % by weight instead of 2 % by weight, because FUJIYAMA allegedly teaches that 1-10 % by weight of glycerol can be added to an emulsion of the type disclosed in SCHREIBER.

Initially, it is noted that even if one were to assume, *arguendo*, that FUJIYAMA teaches that the concentration of glycerol in the emulsions of SCHREIBER can theoretically be increased up to 10 % by weight, there is no apparent reason for one of ordinary skill in the art to increase the concentration of glycerol in the emulsions of SCHREIBER, let alone by a factor of at least 2.5.

As set forth above, SCHREIBER does not even mention glycerol in the body of the specification, let alone explain why in the emulsions described therein the presence of glycerol (in a concentration of 2 % by weight) is associated with any particular advantage. Clearly, SCHREIBER does not convey the impression that concentrations of glycerol of higher than 2 % by weight would be desirable.

FUJIYAMA does not cure the above deficiencies of SCHREIBER. Specifically, FUJIYAMA discloses a cosmetic stick which is prepared from a water-in-oil emulsion which comprises 1 to 50 weight % of water, 1 to 10 weight % of a polyhydroxy compound selected from glycerol, mannitol, dulcitol and carbohydrates, 1 to 5 weight % of oleic acid esters of polyhydric alcohols and the balance consisting of a cosmetic base material (see Abstract). In the passage from col. 2, line 64 to col. 3, line 45 FUJIYAMA states (emphases added):

The cosmetic stick of the present invention is prepared by the following procedure.

An aqueous solution of 1 to 10 parts, preferably, 5 to 7 parts by weight of the specified polyhydroxyl compound is mixed with 1 to 5 parts, preferably of 2 to 3 parts by weight of the specified non-ionic surface active agent to form a gel. The gel is mixed with a predetermined quantity of the cosmetic base material at a temperature of 50° - 60°C while stirring. Thereafter, water is mixed into the above-prepared cosmetic base material-gel mixture while stirring, whereby the water is uniformly emulsified into the cosmetic base material. The water mixed with the cosmetic base material-gel mixture is in the range from 1 to 50%, preferably, 10 to

20% by weight. More than 50% by weight of water results in high evaporation and low rigidity of the cosmetic stick. Less than 1% by weight of water is insufficient to provide a cosmetic stick capable of accomplishing the object of the present invention.

[...]

In the preparation of the conventional cosmetics, a relative large amount of surface active agent is used for emulsifying water into the hydrophobic cosmetic base material. The use of the large amount of surface active agent result in disadvantages of the resultant cosmetic stick namely, relatively high irritation to the human skin, high toxicity, discoloration of coloring matter, difficulty in control of hydrophile-lipophile balance (HLB) and formation of numerous pin holes due to bubbles produced in the cosmetic material. Especially, it is difficult to select the surface active agent having a suitable HLB for the combination of water and the cosmetic base material used.

In the method of preparation of the cosmetic stick of the present invention, the water is uniformly emulsified by using a relatively small amount, 1 to 5% by weight of the non-ionic surface active agent, because the surface active agent is preliminarily mixed with the polyhydroxyl compound which is highly hydrophilic and formed into a gel. The gel is effective for uniformly emulsifying water in the hydrophilic cosmetic base material.

Accordingly, FUJIYAMA employs the polyhydroxyl compound mentioned therein (which may, for example, include glycerol) solely because by using the polyhydroxyl compound it is possible to prepare a uniform water-in-oil emulsion without having to use more than 5 % by weight of the surface active agent when using the preparation method described therein.

A review of the Examples of SCHREIBER reveals that the emulsions described therein with 2 % by weight of glycerol contain much less than 5 % by weight of surface active agent and in fact even less surface active agent than in many of the Examples of FUJIYAMA, wherefore in view of the teaching of FUJIYAMA there is no apparent reason for one of ordinary skill in the art to increase the concentration of glycerol in the emulsions of SCHREIBER to more than 2 % by weight. At any rate, even FUJIYAMA describes a cosmetic stick with a glycerol concentration of much less than 5 % by weight, i.e., only 3 % by weight (see Example 8).

It must further be kept in mind that there are significant differences between the emulsions of SCHREIBER and FUJIYAMA. For example, according to SCHREIBER the water content of the cosmetic stick is preferably between 50 and 75 % by weight (see, e.g., col. 10, lines 1-4), whereas water concentrations in the stick of FUJIYAMA are preferably significantly lower, i.e., from 10 % to 20 % by weight (see, e.g., claim 7 of FUJIYAMA) and in any event not higher than 50 % by weight. Accordingly, there is not even motivation for one of ordinary skill in the art to combine SCHREIBER with FUJIYAMA.

Applicants submit that for at least all of the foregoing reasons, SCHREIBER in view of FUJIYAMA fails to render obvious the subject matter of any of the present claims, wherefore withdrawal of the rejection under 35 U.S.C. § 103(a) over SCHREIBER in view of FUJIYAMA is warranted and should be withdrawn, which action is respectfully requested.

***Response to Remaining Rejections under 35 U.S.C. § 103(a)***

Claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over SCHREIBER in view of FUJIYAMA and in further view of BUTUC and claims 13 and 14 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over SCHREIBER in view of FUJIYAMA and in further view of FABRISI.

Applicants note that claims 8, 13 and 14 are dependent claims. As has been set forth above, the corresponding independent claim is not rendered obvious by SCHREIBER in view of FUJIYAMA, wherefore the same automatically applies to claims 8, 13 and 14. In view thereof,

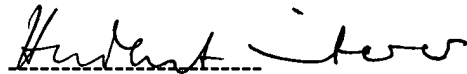
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Applicants refrain from commenting on the allegations with respect to claims 8, 13 and 14 which are set forth in the present Office Action, without admitting however, that these allegations are of any merit.

### CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application (i.e., not only claim 36 which has already been indicated to be allowable) are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,  
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